

REMARKS

I. Introduction

Claims **1-3 and 7-21** are currently pending in the present application. Claims **1, 7 and 19** are independent. Claims **19-21** are withdrawn by the Examiner. All pending claims stand rejected.

In particular:

(A) claims **19-21** are withdrawn by the Examiner as being directed allegedly to a non-elected invention (“an apparatus for vending product under distributed control of plural dispensing units”);

(B) claims **1-3** stand rejected under 35 U.S.C. §102(b) for allegedly being anticipated by U.S. Patent Application Publication No. 2002/0116262 (hereinafter “Mitchell”);

(C) claims **7-11, 13-15, 17 and 18** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Mitchell in view of U.S. Patent Application Publication No. 2001/0046851 (hereinafter “Yamaguchi”);

(D) claim **12** stands rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Mitchell in view of U.S. Patent No. 6021362 (hereinafter “Maggard”);

(E) claim **12** stands rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Mitchell in view of U.S. Patent No. 6247612 (hereinafter “Kaufman”); and

(F) claim **16** stands rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Mitchell in view of Yamaguchi and U.S. Patent No. 6397193 (hereinafter “Walker”).

Upon entry of this amendment, which is respectfully requested, claim **7** will be amended *solely* for clarification of certain embodiments (and not in direct response to any art of record), and new claims **22 and 23** will be added. Claim 15 will be cancelled without prejudice. No new matter is believed to be introduced by this amendment.

Applicants respectfully traverse and request reconsideration of the requirement for restriction of claims 19-21 from examination.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein.

II. Applicants Traverse the Restriction and Withdrawal of Claims 19-21 from Examination

Claims **19-21** were withdrawn by the Examiner as allegedly being directed to a non-elected invention independent or distinct from the invention originally claimed. Although Applicants have marked claims 19-21 as withdrawn in this paper, as required, Applicants respectfully traverse the restriction requirement as it is not supported by substantial evidence made of record. Applicants request reconsideration of the withdrawal of Claims 19-21 from examination.

The Office Action describes claims 19-21 as being drawn to “an apparatus for vending product under distributed control of plural dispensing units.” The Office Action also alleges: “Invention II has separate utility for controlling separate vending machines.”

Applicants respectfully note that none of claims 19-21 appears to require “distributed control” or “plural dispensing units” or “controlling separate vending machines” on its face. The Office Action does not explain this interpretation of the plain language of the claims.

Regardless, and assuming for the sake of discussion here that the Examiner is interpreting claims 19-21 correctly as being directed to such features, the functionality provided by the vending machine claim 19, for example, is substantially similar to that of method claim 1, which the Examiner alleges is directed to a different invention. No explanation is provided as to how the language of claim 19 provides the utility of “controlling vending machines” but the similar language of claim 1 somehow does not provide such utility. The Examiner appears to be ascribing different meanings to similar language, without explaining the reason for the different treatment.

Because at least claim 19 does not appear to be limited to “controlling vending machines,” and the Office Action does not provide any reasoning or evidence in support of this assessment of the scope of claim 19, Applicants regretfully must traverse the definition of the alleged “Invention II.” As this assertion appears to be in error and is the basis for the Examiner’s finding that there are two separate or distinct inventions, and it

appears to contradict the clear language of the claims, Applicants respectfully request withdrawal of the restriction requirement and examination of all of claims 1-3 and 7-21.

Applicants also respectfully note that Invention I is described as “for vending combination products contingent.” Applicants respectfully note that although some claims may provide for the vending of a combination of products, the plain language of claims 1 and 7, for example, does not require any “combination products” or vending such “combination products.” The Examiner does not explain the claim construction that resulted in this characterization of Invention I, or why claims 1 and 7, for example, are designated as being directed Invention I when they are not limited to “combination products” or vending “combination products.”

Because at least claims 1 and 7 do not appear to be limited to “combination products contingent,” and the Office Action does not provide any reasoning or evidence in support of this assessment of the scope of claims 1 or 7, Applicants respectfully must traverse the definition of the alleged “Invention I.” To the extent the Office Action relies on this mischaracterization of at least some of the indicated claims of “Invention I,” Applicants respectfully request reconsideration and withdrawal of the characterization of “Invention I” and reconsideration and withdrawal of the restriction of claims 19-21 from examination.

III. The Examiner’s Rejections

A. 35 U.S.C. §102(b) – Mitchell

Claims **1-3** stand rejected under 35 U.S.C. §102(b) for allegedly being anticipated by Mitchell. Applicants respectfully traverse this ground for rejection with respect to remaining claims **1-3** for at least the reasons stated in their prior response and as follows.

1. The cited reference fails to teach or suggest: *transmitting a promotional message...which...includes a code that is redeemable for a benefit at the vending machine*

Applicants respectfully assert that Mitchell fails to teach or suggest limitations of claims **1-3**. For example, Mitchell fails to teach or suggest *transmitting a promotional*

message...which...includes a code that is redeemable for a benefit at the vending machine.

The Examiner is correct that Mitchell describes transmitting messages to e-mail addresses of customers. Those messages are described, in Mitchell, as including a password and a link to a rewards website. The customer in Mitchell can utilize the password to access the rewards website and receive benefits.

A password for accessing a website, however, does not teach *a code that is redeemable at the vending machine*, as claimed. Nowhere does Mitchell describe such a concept, much less provide adequate written description thereof.

The Final Office Actions asserts: “A password is a code.” [page 9]. Contrary to what is implied by the Final Office Action by this statement, Applicants were not arguing in their prior response that the “password” of Mitchell does not teach a *code* as recited in claim 1. Applicants do not necessarily agree or disagree that the “password” of Mitchell teaches a *code* as recited in claim 1.

What Applicants explained in their prior response is that the previous Office Action did not articulate any explanation as to how a password for accessing a website, as the password is described in Mitchell, teaches a code that is redeemable at the vending machine. The Final Office Action also does not provide any such explanation.

Mitchell does not appear to teach that a user could use the described “password” at a vending machine to access “the website”; the Office Action does not assert otherwise. To the contrary, Mitchell describes transactions at a vending machine as being “off-line,” in contrast to how Mitchell describes a user accessing a website. Accordingly, Mitchell does not teach using a password or code (or other type of information) to redeem a benefit at a vending machine.

At least because Mitchell fails to teach or suggest *transmitting a promotional message...which...includes a code that is redeemable for a benefit at the vending machine*, the Office Action does not establish a *prima facie* case of anticipation of any of claims 1-3. Applicants respectfully submit that Mitchell otherwise fails to anticipate claims 1-3. Applicants request the Examiner’s reconsideration and withdrawal of the Section 102(b) rejection of claims 1-3.

B. 35 U.S.C. §103(a) Rejections

Claims **7-11, 13-15, 17 and 18** stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Mitchell in view of Yamaguchi. Applicants traverse this ground for rejection as follows.

Claim **12** stands rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Mitchell in view of Maggard.

Claim **12** stands rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Mitchell in view of Kaufman.

Claim **16** stands rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over Mitchell in view of Yamaguchi and Walker.

1. Examiner's Response to Arguments

In response to Applicants' prior arguments that neither Mitchell and Yamaguchi, alone or in combination, teach or suggest a feature of *determining at least one rule defining restrictions on when a message may be sent to at least one of the email addresses*, the Office Action states:

Identifying when messages may not be sent inherently defines time windows when messages may be sent by virtue of it being the Boolean component. Those windows of time in which messages may be sent comprise a scheduling of messages. A scheduling may comprise windows of time-scheduling is not limited to specific trigger or send times. "Scheduling" is not so narrow as to specifying specific message send trigger times.

[page 9]. Applicants respectfully disagree with the Examiner's analysis, for at least the reasons stated in their prior reply.

However, solely in order to provide for desirable embodiments for business purposes and not for any reason related to the assertion of obviousness of any claim, Applicants have amended Claim 7 in order to provide for a feature of *wherein the content of the message that promotes the vending machine comprises an indication of a code that is operable, upon being input into the vending machine, to cause the vending machine to dispense a discounted unit of a product*, as previously recited in claim 15 (now cancelled).

2. No *Prima Facie* Case of Obviousness

The Examiner has failed to show how every element of the claims is taught or suggested by the cited references and the Examiner has entirely failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. The Examiner has further failed to set forth a valid reason that would have led one of ordinary skill in the art to combine and/or modify the cited references as suggested by the Examiner. At least for these reasons, as described in more detail hereinafter, the Examiner has failed to establish a *prima facie* case for obviousness.

- a) **The Examiner has failed to provide evidence that the references teach or suggest:** *wherein the content of the message that promotes the vending machine comprises an indication of a code that is operable, upon being input into the vending machine, to cause the vending machine to dispense a discounted unit of a product*

Applicants respectfully assert that the Examiner has failed to provide evidence that Mitchell and Yamaguchi, alone or in combination, teach or suggest limitations of claims **7-11 and 13-18**. For example, the Examiner has failed to provide evidence that Mitchell and Yamaguchi teach or suggest *wherein the content of the message that promotes the vending machine comprises an indication of a code that is operable, upon being input into the vending machine, to cause the vending machine to dispense a discounted unit of a product*.

The Examiner relies on paragraph [64-68] of Yamaguchi as allegedly providing evidence of a teaching or suggestion of the above-quoted limitation. Final Office Action, pg. 5.

Applicants have reviewed the cited portion and respectfully note that the cited portion of Yamaguchi does not describe HTML code being sent to each of a set of email addresses, the HTML code being able to cause the vending machine to dispense a unit of product.

Accordingly, at least because the Examiner has failed to provide evidence of the above cited feature the Examiner has failed to provide evidence setting forth a *prima facie* case of obviousness for any of claims **7-11 or 13-18**.

Applicants therefore respectfully request that this §103(a) ground for rejection of claims **7-11 and 13-14 and 16-18** be **withdrawn**.

With respect to Claim 12, Mitchell does not teach all of the features of Claim 1, as described above. Neither Maggard nor Kaufman make up for all of the deficiencies of Mitchell; the Final Office Action does not assert otherwise.

Applicants therefore respectfully request that this §103(a) ground for rejection of claim **12** be **withdrawn**.

IV. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested. Applicants' silence with respect to any comments made in the Final Office Action does not imply agreement with those comments.

If there remain any questions regarding the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 438-6408 or via e-mail at mdowns@finchamdowns.com, upon the Examiner's convenience.

V. Fees and Petition for Extension of Time to Respond

While no fees are believed to be due at this time, please charge any fees that may be required for this Supplemental Reply to Applicants' Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Applicants' Deposit Account No. 50-0271.

Respectfully submitted,

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